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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/644,310

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Lance R. Peterson

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BELL, BOYD & LLOYD LLP  
P.O. Box 1135  
CHICAGO, IL 60690

EXAMINER

MCCULLOCH JR, WILLIAM H

ART UNIT

PAPER NUMBER

3714

NOTIFICATION DATE

DELIVERY MODE

09/25/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

<b>Office Action Summary</b>	<b>Application No.</b> 10/644,310	<b>Applicant(s)</b> PETERSON ET AL.	
	<b>Examiner</b> William H. McCulloch	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-93 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-93 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Applicant's submission filed on 7/17/2008 has been entered. Claims 1-93 are pending in the application, with claims 1, 28, 40, 48, 56, 74, and 85 currently amended.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,203,430 to Walker et al. (hereinafter Walker) in view of U.S. 6,491,584 to Graham et al. (hereinafter Graham). This rejection was made in a previous Office Action and is maintained and incorporated herein.

Regarding claims 1, 2, 28, 29, 41, 42, and 74, Walker teaches a gaming device and method comprising: a plurality of reels (see at least fig. 3B and description thereof); a plurality of symbols on the reels, said symbols including at least one first prize symbol and at least one second prize symbol (see at least figs. 3B, 4A, 8, and descriptions thereof, and 8:14-23); an initial designated number of spins of the reels, said designated number being greater than one (see at least 3:33-51); a designated number of the first prize symbols necessary to be accumulated to win a first physical prize, wherein the

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designated number of first prize symbols is greater than the number of first prize symbols which can possibly be accumulated in the initial designated number of spins of the reels (e.g., in the case where an initial designated number of spins equals two, each spin providing a maximum of nine symbols, and the player is unable to win a minimum prize requiring 75 orange symbols; see at least fig. 8); a designated number of the second prize symbols necessary to be accumulated to win a second different physical prize, wherein the designated number of second prize symbols is greater than the number of second prize symbols which can possibly be accumulated in the initial designated number of spins of the reels (e.g., given two initial spins, the player is unable to achieve the minimum of 50 bar symbols; see at least fig. 8); and a processor operable to control the reels, activate the reels for the initial designated number of spins, accumulate any first prize symbols which occur on the reels in each spin of the reels, accumulated any second prize symbols on which occur on the reels in each spin of the reels, award the first physical prize to the player if the accumulated number of first prize symbols reaches the designated number of first prize symbols, and award the second physically prize to the player if the accumulated number of second prize symbols reaches the designated number of second prize symbols (see at least 6:9-7:5 and 8:14-9:13).

Walker teaches the invention substantially as described above, but lacks in explicitly disclosing at least one re-trigger symbol or predetermined symbol combination (that causes re-triggering). In a related disclosure, Graham teaches a gaming machine with a re-trigger bonus, in which predetermined events, such as one or more triggering

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symbols appearing in an outcome of the game, initiate free or bonus games (see at least abstract, 1:29-2:26). It would have been obvious to modify the invention taught by Walker to include the re-trigger features of Graham in order to retain and attract potential gaming customers, as is favorably taught by Graham (see at least 1:12-26). It is noted that Graham explicitly teaches that the inventive bonus feature is “applicable in respect of any type of base games played on a gaming machine” and “particularly applicable in respect of spinning reel-type base games” (2:16-20). This teaching suggests further motivation to apply the concepts of Graham to the spinning reel type base game of Walker.

Claims 40, 56, 61 are directed toward similar subject matter to the above claims, and additionally include a primary and secondary game, wherein at least one triggering event associated with the primary game initiates the secondary game. Walker teaches such at least by an initial game(s) ending and additional games beginning. Additionally, Graham teaches initiation of a number of bonus games upon a triggering event (see at least 1:29-2:26), which also meets the above limitation of primary and secondary games.

Claims 22, 34, 43, 48, 49, 67, 77 and 85 are directed toward similar subject matter to the above claims, except that an initial designated number of free spins of the reels are provided, with the opportunity to re-trigger at least one spin of the reels if the re-trigger symbol or a predetermined symbol combination occurs on the reels. Graham teaches such feature in at least 1:29-45 and 2:21-25.

Regarding claims 3, 4, and 57 Walker teaches at least one pay line associated with reels and further teaches that the processor accumulates any prize symbols that occur on any of the paylines in each spin of the reels (see at least fig. 3B, 4:45-51, 6:21-33, and claim 17).

Regarding claims 5, 7, and 30, Walker teaches that the accumulated number of prize symbols is reset when no spins remain or after a plurality of primary games (see at least 3:21-51).

Regarding claims 6 and 31, Walker teaches that the initial designated number of spins is obtained in a primary game activated upon a wager by the player (see at least 6:9-15).

Regarding claim 8, Walker teaches a prize symbol that includes an image that represents the physical prize (see at least figs. 4A and 8, and descriptions thereof).

Regarding claims 9-10, Walker teaches that the initial designated number of spins is predetermined or random (see at least figs. 9A and 9B, and descriptions thereof).

Regarding claims 11-12, Walker teaches that the designated number of prize symbols is predetermined or random (see at least fig. 8 and descriptions thereof).

Regarding claims 13 and 14, Walker teaches a plurality of different physical prizes, wherein the processor is operable to provide one of said physical prizes to the player when the accumulated number of prize symbols reaches the designated number of prize symbols necessary to win the physical prize; and further teaches that at least

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two of the physical prizes have different values (see at least fig. 8 and descriptions thereof).

Regarding claims 15 and 16, Walker teaches a probability of being selected by the processor associated with each of the physical prizes, wherein the processor is operable to select and provide one of the physical prizes to the player based on said probabilities (see at least 7:36-8:2).

Regarding claims 17-21 and 62, Walker teaches a prize symbol display operable to indicate the number of accumulated prize symbols (fig. 3b, element 360), further including a plurality of prize symbols indicators (fig. 3b, element 360), further including an illumination device associated with the prize symbols indicators (fig. 3A, video display 336), wherein the prize symbol display includes an integer which represents the accumulated number of prize symbols (fig. 3b, element 360), and wherein the integer increments by at least one for each prize symbol which occurs on the reels (see at least 3:21-51 and 5:43-51).

Claims 23-26, 35-39, 44-47, 51-55, 58-60, 68-71, 78-82, and 87-91 are directed toward determining that 1) the initial number of spins, 2) prize symbols necessary to win a prize, 3) number of prize symbols, and 4) odds of obtaining a re-trigger event, is based at least in part on a wager made by the player. Each of these determinations is described at least by the citations of Walker herein because each determination must be established when the player initiates a wagering session. Teachings of Walker further dictate that the initiation is a result of the player making a wager. Therefore, Walker anticipates each of the above claims.

Regarding claims 27, 63, and 64, Walker further teaches the processor is operable to enable the player to select the physical prize from a plurality of prizes (see at least 11:61-12:14).

Regarding claims 32, 33, 50, 75, 76, 86, Walker describes a first physical prize that is of a higher value than the second physical prize, and further describes a higher probability of obtaining the second physical prize than the first physical prize (see at least fig. 8).

Regarding claims 65-66, Walker teaches awarding the physical prize to the player includes generating a prize code and further includes placing the prize code on at least one of: a receipt, a ticket, a printing medium and a recording medium (see at least 9:6-13).

Regarding claims 72, 73, 83, 84, 92, and 93, Walker teaches that the above described system and method are controller through a data network (see at least 5:1-25 and 8:24-32). The Internet is simply a group of networks in communication with one another. Therefore, Walker suggests controlling the method and system over the Internet.

### ***Response to Arguments***

4. Applicant's arguments filed 7/17/2008 have been fully considered but they are not persuasive.

Applicant states on pages 25-26 of the Remarks that the claimed invention now recites that the reels of the gaming machine may be activated 'until none of the initial designated number of spins remain.' Applicant argues that Walker does not teach or



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suggest activating the reels until none of the initial designated number of spins remains.

The Examiner respectfully disagrees.

The meaning of 'an initial designated number of spins' is set forth by the claimed invention as follows: (1) the initial designated number of spins must be "greater than one", and (2) the initial designated number of spins must be sufficiently high such that "the designated number of prize symbols is greater than the number of prize symbols which can possibly be accumulated in the initial designated number of spins of the reels" (quoted from claim 1; similar recitations appear in the remaining claims).

According to the two criteria above, Walker meets the limitation of an initial designated number of spins as claimed. For instance, Walker teaches:

"According to the present invention, a player begins a gaming session at a slot machine. During the session, the player plays a number of games, and generates an outcome for each game. Each outcome is represented by a set of symbols." (4:40-44)

Therefore, Walker meets the first criterion above that the "initial designated number of spins" is "greater than one" because a gaming session comprises "a number of games," that number being one or more. See also Walker 9:26-34. For purposes of discussion, let us assume the number of games in the session of Walker (analogous to the "initial designated number of spins") to be two. To explain the second criterion, the Examiner points to analysis presented in the previous Office Action mailed 5/9/2008. On pages 8-9 of the action, the Examiner explained that in at least one of Walker's embodiments, the game matrix of three rows and three columns could produce a maximum of nine "orange" symbols per game. The minimum number of orange symbols required for a prize is 75. Recall from above that the assumed number of initial spins is two. This

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means that the player could not possibly win enough orange symbols to collect a prize in the two-game session. This means that Walker meets the second criteria, and therefore meets the claimed invention.

Applicant has further argued that the number of activations of the reels is "limited" by the initial designated number of spins. It is clear that the claimed invention activates the reels for an initial designated number. Yet it is also clear that the claimed invention does not stringently limit the number of spins, but rather dictates a minimum number of spins. Specifically, the claimed re-triggering of the reels allows for more spins beyond the initial designated number of spins. For instance, let us again assume that the initial designated number of spins is two, and that the player receives one re-trigger symbol. Clearly the number of spins is not limited to two, as is apparently the logic of the Applicant, but rather the *minimum* number of spins is two, and the *actual* number is three.

As is discussed above, the combination of Walker and Graham allows for an initial designated number of spins that provides a minimum number of spins and also allows for re-triggering to provide at least one additional spin of the reels. Because neither Walker nor the claimed invention "limit" the activation of reels in the manner argued by the Applicant, the contention that Walker "teaches away" from various claim limitations or that Walker and Graham are somehow incompatible under §103 is unpersuasive.

Amended claims 48 and 85 now require that the re-trigger symbol or a predetermined symbol combination that causes re-triggering must occur on the reels to

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accumulate the designated number of first and second prize symbols. The Examiner interprets this recitation to mean that the player must receive at least one spin in addition to the initial designated number of free spins. This situation is directly analogous to the situation described above with respect to Walker, the only difference being that the initial designated number of spins is instead an initial designated number of *free* spins.

The combination of Walker and Graham teaches the features of claims 48 and 85 for at least the following reasons. Walker teaches a gaming session with one or more spins of the reels, and Graham teaches a bonus feature with one or more free spins of the reels (e.g., Graham 2:21-25). Let us assume for purposes of discussion that the combined teachings of Walker and Graham provide for five initial free spins of the reels. The player could achieve a maximum of nine symbols for a first prize, nine symbols for a second prize, or an amount split between the two (such as one first prize symbol and eight second prize symbols). For simplicity, let us only consider the case where the player strives for second prize symbols with the understanding that a similar situation occurs for the first prize symbols. Thus, the player could achieve a maximum of nine second prize symbols in each of five spins, for a total of 45 second prize symbols. This is not enough for the player to achieve the minimum prize that, as taught by Walker, required 50 “bar” symbols to win (fig. 8). Therefore, the player *must* achieve a re-trigger outcome such that he is awarded at least one additional free spin (on top of the five initial designated free spins) in order to even have the opportunity to win enough second

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prize symbols for the 50 necessary for a prize. This situation is exactly the same as that of the claimed invention.

For at least these reasons, the claimed invention is unpatentable over the prior art of record.

### ***Conclusion***

5. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch whose telephone number is (571) 272-2818. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. H. M./  
Examiner, Art Unit 3714  
9/17/2008

/Corbett Coburn/  
Primary Examiner  
AU 3714